

### **Remarks**

Claim 1-4, 6 and 7 are pending. Claim 5 has been canceled.

Claims 1 and 7 have been amended to recite the subject matter of the last full paragraph of page 18 of the present specification. No new matter has been added by way of the above-amendment.

### **Prior Art Based Issues**

The following Rejections are pending:

- A. Claims 1, 6 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over European 0506465 (EP '465);
- B. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '465; and
- C. Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 103(a) as unpatentable over U.S. 6,020,427<sup>1</sup> (Abraham '427) in view of EP '465.

Applicants respectfully traverse Rejections A-C.

As noted above, independent claims 1 and 7 have been amended to be limited to thermoplastic elastomer composition comprising a mixture of a rubber (B) and a polyamide based polymer (A-1) in a mixing ratio (A1):(B) of 30:70 to 80:20 by weight. Applicants respectfully submit that the inventive composition is not made obvious by EP '465 either alone or in combination with Abraham '427.

With respect to EP '465, the teachings of EP '465 are limited to the use of a polyester-based thermoplastic elastomer containing 51-95 wt% of a thermoplastic polyester elastomer and 49-5wt% of a rubber, see abstract. It is noted that EP '465 mentions that polyester elastomer composition can be blended with a variety of resins, see the 2<sup>nd</sup> full paragraph on page 8 of EP '465. Within this long list of resins, EP '465 includes polyamide as one of many

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<sup>1</sup> The Examiner has incorrectly identified the patent number of Abraham et al. as US 6,020,417.

possible options. However, there is no teaching or suggestion in EP '465 to include the polyamide in a mixing ratio (polyamide):(rubber) of 30:70 to 80:20 by weight, as presently claimed. As such, significant patentable distinctions exist between the presently claimed invention and the teachings of EP '465.

Applicants now turn to the teachings of Abraham '427. Abraham '427 teaches the combination of a thermoplastic polymer with a carboxylated nitrile rubber. "Suitable thermoplastic polymers include polyesters, polycarbonates, block copolymers of polyester, and the like." See column 2, lines 7-19 of Abraham '427. However, there is no teaching or suggestion in Abraham '427 to include the polyamide resin. As such, the combination Abraham '427 and EP '465 do not teach or fairly suggest all of the limitations of the presently claimed invention. As the MPEP directs, all the claim limitations must be taught or suggested by the prior art to establish a *prima facie* case of anticipation or obviousness. See MPEP §§ 2131 and 2143.03.

In view of the fact that EP '465, either alone or in combination with Abraham '427, do not teach or fairly suggest a thermoplastic elastomer composition comprising a mixture of a rubber (B) and a polyamide based polymer (A-1) in a mixing ratio (A1):(B) of 30:70 to 80:20 by weight, as presently claimed, the present invention is neither anticipated nor rendered obvious. As such, withdrawal of Rejections A-C is respectfully requested.

### **Provisional Obvious-Type Double Patenting Rejection**

The Examiner has provisionally rejected claims 1-6 on the ground of non-statutory obvious-type double patenting as being unpatentable over claims of copending Application No. 11/631,293 (hereinafter "the '293 application"). Applicants respectfully traverse the provisional rejection. The Examiner asserts that conflicting claims are not patentably distinct from each other because they contain overlapping subject matter.

Applicants respectfully disagree with the Examiner and find that the rejection is untenable in view of the differences between the present claims and the claims of the '293

application. The '293 application requires a polyester having a specific MFR range and the present claims are silent on this feature. Also, the present claims require: i) a specific gel content range of rubber (B); ii) a polyamide based polymer (A-1); and iii) that the mixture of rubber (B) and a polyamide based polymer (A-1) in a mixing ratio (A1):(B) of 30:70 to 80:20 by weight. The claims of the '293 application are silent on this feature.

Simply because there is some overlap in the claims does not mean that obvious-type double patenting exists. The Examiner is required to find a reference which properly can be combined with the claims of the '293 application which teaches a specific gel content range of rubber (B) as presently claimed for there to be obviousness-type double patenting.

As such, withdrawal of the provisional rejection is respectfully requested.

Conclusion


In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq., Reg. No. 43,575 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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